



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,087	06/20/2003	Jotinderpal S. Sidhu	07K8-105445	8674

30764 7590 07/25/2006

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP  
333 SOUTH HOPE STREET  
48TH FLOOR  
LOS ANGELES, CA 90071-1448

EXAMINER

VARGOT, MATHIEU D

ART UNIT PAPER NUMBER

1732

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/601,087	<b>Applicant(s)</b> SIDHU ET AL.	
	<b>Examiner</b> Mathieu D. Vargot	<b>Art Unit</b> 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1732

1. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claims 1 and 13 to recite that the insert is heat soaked "without the application of pressure or vacuum to the insert, such that the insert is warmed but does not lose its structural integrity". However, no support for this language can be found in the specification as originally filed. Applicant is requested to point out exactly where support exists or cancel the language from the claims. It is noted that applicant discloses that prior art methods involving pressure and/or vacuum are not always effective. However, this in and of itself does not provide support for the negative limitations as presently presented. Negative limitations require clear support in the specification.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhalakia et al (see col. 18, lines 12-67), either alone, or further in view of Hirmer et al (see col. 7, lines 53-55).

Art Unit: 1732

The primary reference (see Figs. 5 and 6 and the above-noted passage) discloses the basic claimed process by providing a mold cavity (104) configured for use in injection molding an optical part and placing an optical part insert (plate 17) in a position resting against a molding surface (recess 172) of the mold cavity, the insert being a multiple layered polarizer film. Essentially, the primary reference fails to explicitly teach that the insert is heat soaked, that it has a curvature measurably different from that of the mold cavity and the particular use of the instant IR, UV, microwave and radio frequency heating. Concerning the former, it is noted that the molds are heated to a temperature of 265 deg F (col. 21, line 5) in Bhalakia et al and this is submitted to render a heat-soaking of the plate as obvious. Indeed, if the molds are already heated before the injection, then placing the insert into the mold provides for heating the insert and the duration of heating—ie, delay between placing the insert in the mold and injecting the resin-- would determine whether the insert were heat-soaked as generally disclosed in the instant specification. Also, the embodiment wherein the plate is preshaped outside the mold to generally fit within the mold is being used for the instant rejection—not the embodiment where the plate is preformed in the injection mold using vacuum methods. While Bhalakia et al chooses to preshape the insert to match the mold recess, it is submitted within the skill level of the art to preshape the insert so that its curvature is measurably different than that of the mold recess dependent on need to exhaust air from the mold. The exact curvature of the insert would have been readily determined through routine experimentation. Hirmer et al has been additionally applied to show that preheating a film in an injection mold advantageously improves the bonding, this

Art Unit: 1732

dependent on the thickness of the film. The exact heating method used would have been within the skill level of the art. Note that all of the instant heating methods are conventional and would have been obvious methods by which the insert/plate of the primary reference would be heat-soaked.

3.Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In view of the new grounds of rejection, applicant's comments with respect to previously applied Beeloo et al and Smith are now moot. Needless to say, Bhalakia et al teaches a process closer in spirit to the instant claims.

4.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1732

you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot  
July 21, 2006

  
Mathieu D. Vargot  
Primary Examiner  
Art Unit 1732

7/21/06